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OFFICE OF PETITIONS

In re Application of
Garner
Application No. 10/714,241
Filing Date: 13 November, 2003
Attorney Docket No.: (None)

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DECISION

This is a revised decision on the petition filed on 12 April, 2006, seeking to revive the application as having been abandoned due to unintentional delay 37 C.F.R. §1.137(b).

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.137(b) is **GRANTED**.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 10 December, 2004, with reply due absent extension of time on or before 10 March, 2005;
- on 2 March, 2005, Petitioner filed a paper, entitled: "Claims" and comprised of two (2) pages, however, on 8 July, 2005, the Office mailed a Notice of Non-Compliant Amendment and set a one- (1-) month period of response;¹

¹ This Notice incorrectly reflects the receipt date of the filing as "04-02-05" (emphasis added), rather than the correct receipt date of 2 March, 2005.

- it was Petitioner's failure to reply timely and properly to the 8 July, 2005, which then resulted in the application going abandoned after midnight 8 August, 2005;
- Petitioner submitted additional papers on 24 August, 2005, however, as noted above, the application already had gone abandoned;
- the Office mailed the Notice of Abandonment on 31 January, 2006;
- on 17 February, 2006, Petitioner filed a the original paper (considered as a petition under 37 C.F.R. §1.181, inter alia, because Petitioner has failed to submit the petition with any fee), and with the allegation that he has been in contact with the Examiner (documented by the Examiner's Interview Summary) and that Petitioner had responded to the office action, and that petition was dismissed on 31 March, 2006, for failing to satisfy the burdens under the rule;
- with the instant petition, Petitioner files the reply and makes the statement of unintentional delay.

Out of an abundance of caution, Petitioner once again is reminded that all practice before the Office is in writing (see: 37 C.F.R. §1.2²). Moreover, Petitioner must be responsive within the time limits set out by the Office in Office actions because these time periods are statutorily set by Congress and cannot be altered by the Office.)

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).³

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is

² The regulations at 37 C.F.R. §1.2 provide:
§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

³ 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.⁴

Delays in responding properly raise the question whether delays are unavoidable.⁵ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁶ And the Petitioner must be diligent in attending to the matter.⁷ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁸))

Allegations as to Unintentional Delay

The requirements under the rule are a petition, fee, reply, statement of unintentional delay, and—where appropriate—a terminal disclaimer and fee.

Petitioner appears to have satisfied those requirements.

CONCLUSION

The petition under 37 C.F.R. §1.137(b) is **granted**.

The instant application is released to Technology Center 3700 for further processing in due course.

⁴ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁵ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁶ See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁷ See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

⁸ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

A handwritten signature in black ink, appearing to read 'John J. Gillon, Jr.', with a stylized, cursive script.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions